

REMARKS

Status of the claims

In his December 30, 2003, Office Action, the Examiner rejected claim 1 under § 112, ¶ 2; claims 1-5 and 7-8 as anticipated; and the remaining claims as obvious over certain prior art references.

Applicant has made substantial clarifying amendments to claims 1, 2, 7 and 9-10 supported by pages 10-13 and 16 and 19 of the specification, and added new claims 11-14. None of the amendments add new matter. Applicant has cancelled claim 8 in view of the changes made to claim 7 and 9.

Information Disclosure Statement

The Examiner objected to the IDS's of 4/04/2001 and 9/26/2003 for not including a concise explanation of the relevance of each patent not listed in the English language. But upon review, it appears that all of the references listed on those IDSs were in the English language.¹ Furthermore, the Examiner appears to have listed all of the cited IDS references on its own Notice of References Cited, rendering the issue moot. The undersigned welcomes identification of the specific non-English references involved.

Section 112, ¶ 2 Rejections

The Examiner rejected claim 1, objecting to the word "sufficiently" and the lack of antecedent basis for the word "typography." The claim, as amended, does not contain the word "sufficiently." It is respectfully submitted that the claim, as amended, meets the requirements of the second paragraph of 35 U.S.C. § 112. As noted in MPEP 2173.05(f), "[i]nherent components of elements recited have antecedent basis in the recitation of the components themselves. For example, the limitation 'the outer surface of said sphere' would not require an antecedent recitation that the sphere has an outer surface."

Section 102 Rejections

The Examiner rejected claims 1-5 and 7-8 under 35 U.S.C. § 102(e) as anticipated by Sevcik et al., U.S. Patent No. 6,330,542 B1, entitled "Automated Internet Quoting and Procurement System and Process for Commercial Printing."

Applicant has amended claim 1 and respectfully requests reconsideration and withdrawal of the rejection in light of that amendment and the following arguments.

The amendments to claim 1 distinguish the claimed invention from Sevcik because:

¹ The undersigned does not have copies of the non-patent documents that were submitted by the previous attorney with the first IDS. But a quick perusal shows all of those websites to be in English.

- Sevcik provides an interface with which customers can procure quotes for printing jobs in accordance with a catalog of stationery and business card products. Sevcik provides the same catalog to all of its customers. Sevcik does not disclose a system for customizing a prototypical product record for a specific company.
- Sevcik does not disclose a template defining the placement and typography of informational elements to be printed on a business card or stationery product.
- Sevcik does not disclose limiting a print-request selection to a company-tailored prototypical product record and a selected user profile that defines content for one or more of the informational elements provided by the template.
- Sevcik does not disclose processing the user's print order through an interface that is adapted to directly generate a pre-press product automatically incorporating a selected user profile into said tailored product. Sevcik provides no basis for the conclusion that it "merges specific profile data, data entered via entry fields on various interfaces according to templates and prototypes to produce pre-press files." Not only does Sevcik fail to teach or suggest such an operation, it also fails to enable such an operation. Sevcik cannot anticipate any of the claims.

Incidentally, Sevcik discloses an electronic-commerce system for obtaining *quotes* on various print products. It provides a *request-a-quote interface* enabling a user to specify various options, like the paper size, paper color, paper finish, paper weight, ink color, and binding type, and obtain quotes from competing print providers. The first paragraph of the specification neatly summarizes this aspect of Sevcik:

The system allows buyers of printing to receive immediate quotes by selecting simple graphic representations of the product they wish to purchase and selecting any variable information for that product. This procedure saves the buyer significant time and also saves the printing providers significant time in having to prepare the quote.

Col. 1, lines 15-22. Sevcik also discloses a *print provider interface* enabling competing print providers to furnish a "production availability profile and pricing structure, and current contact information." Col. 14, lines 54-55; see also col. 16, line 3 to col. 17, line 45. After a user requests a quote for a specified item within a specified turnaround time to be delivered to a specified zip code, the system "searches the database . . . to find all vendors that have indicated being able to supply that item in the specified turnaround time and finds the ones closest to the delivery zip code" and then "searches for the lowest price for that quantity range and variable options among the vendors that have been identified." Col. 9, lines 26-42.

Sevcik also characterizes the system as enabling a print buyer to register and place print orders. According to Sevcik, the system prompts the buyer to provide credit card information

and billing and shipping information. Col. 14, lines 8-48. Sevcik also describes the system as enabling both print buyers and providers to check, or provide information about, the job status of a pending order. Col. 14, lines 30 - col. 15, line 67.

In summary, Sevcik proposes a system that would provide an efficiency to print providers, namely automating price quotes. It also provides an efficiency to print buyers, namely by providing them with product availability and pricing information from a variety of print providers. By allowing a print buyer to place an order and monitor the job status, the Sevcik system would also facilitate the initialization and job progress review of a transaction between a print buyer and a print provider.

While Sevcik briefly suggests an interface to allow a print buyer to register and place orders, it does not even recognize, much less solve, the problems and inefficiencies of typesetting and proofing identified in the background section of Applicant's specification:

Charges for business cards, stationery products and the like constitute a significant portion of any commercial enterprise's cost of doing business. Due, in general, *to the labor-intensive nature of type-setting* and, in particular, *to the necessity to specifically tailor each product to a particular user's identity and/or office location*, the actual printing costs associated with these items have traditionally far exceeded the costs associated with other print media. . . . [L]arge institutional and conglomerate users often find that a significant number of personnel must be dedicated solely to the functions of order preparation, approval, submission, *proofing*, receiving, receiving, *quality assurance* and distribution. . . .

From the printer's perspective, the processes involved in receiving an order, *typesetting a business card or stationery product and corresponding with the client to proof the order* are typically more involved, and consequently often more costly, than the actual printing of the order. To further the frustration felt by the printer, *the proofing process is ripe for dispute* with the client, leading too often to the difficult decision as to whether to reprint the order free of charge or risk loss of the client by billing on a disputed order. . . .

Clearly, there is a long-standing need for an improved print order system that eliminates these widely varied but unnecessarily cost-increasing functions. . .

Page 2, line 17 – Page 3, line 19 (emphasis added).

Applicant's invention, unlike Sevcik, recognizes the typesetting and proofing problems and describes a system and method to solve them. Claim 1 is directed to a method for fulfillment of institutional business card and stationery product orders that solves the typesetting and proofing problems by directly generating a pre-press product that automatically incorporates a user-indicative profile into a "company tailored product."

With respect to claims 3 and 4, Sevcik does not provide a preview of the company tailored product. Rather, Sevcik enables a print provider (as opposed to a print requestor or other company official reviewing a print order) an ability to preview its own profile and contact information. *See* Sevcik, 14:50 to 15:22, 17:17-22, 35-43. A preview of a print provider's profile and contact information is not a preview of the product.

The amendments to claim 2, 7 and 8 further distinguish the claimed invention from Sevcik, as described by the Examiner with respect to those same claims.

Section 103 Rejections

The Examiner rejected claim 6 as obvious over Sevcik in view of U.S. Patent No. 5,918,214 to Perkowski et al. Applicant respectfully traverses this rejection. To establish a prima facie case of obviousness, all of the following must be true: (1) all of the references relied upon must have been in the prior art (in a chronological sense); (2) all of the references must be either in the field of the inventor's endeavor or in a reasonably pertinent field; (3) the prior art must suggest the desirability of the claimed invention (i.e., a reason, suggestion or motivation for combining the teachings of the references to produce the claimed invention must be present in the prior art); (4) the combination or modification must teach or suggest all of the claimed limitations; (5) a person of ordinary skill in the art must have had a reasonable expectation that the combination or modification would succeed, and (6) the proposed combination or modification cannot render the prior art unsatisfactory for its intended purpose. The combination of these references fails tests 3 and 4, at least, particularly in view of the amendment to claim 1. Applicant respectfully requests withdrawal of the rejection.

The Examiner rejected claim 9 as obvious over Sevcik. Applicant, however, has amended both claims 1 and 9. Sevcik clearly fails to teach or suggest all of the claimed limitations. Applicant respectfully requests withdrawal of the rejection in view of the amendments.

The Examiner rejected claim 10 as obvious over Sevcik et al. in view of Official Notice. Applicant, however, has amended both claims 1 and 10. Sevcik clearly fails to teach all of the claimed limitations. Moreover, the Official Notice does not teach the limitations added by claim 10, as it has been amended. Applicant respectfully requests withdrawal of the rejection in view of the amendments.

New Claims

New claims 11-14 are patentable over Sevcik because:

- Sevcik does not teach, disclose or suggest a system for customizing templates for stationery products that define a plurality of informational elements.

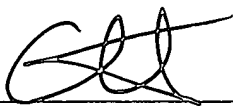
- Sevcik does not teach, disclose or suggest a system for customizing templates for stationery products that define the placement and typographical settings of those informational elements.
- Sevcik does not teach, disclose or suggest a system for providing predefined informational content for the common informational elements, including content identifying a specific organization.
- Sevcik does not disclose a requestor interface that enables the user to define the informational content of only the specific informational elements while denying the user the ability to define or modify the common informational elements.
- Sevcik does not teach, disclose, or suggest processing the user's print order through an interface adapted to directly generate an electrically previewable product automatically incorporating said predeterminable profile into said tailored product.
- Sevcik does not teach, disclose or suggest providing the user with an option to preview the electronically previewable product.

CONCLUSION

Having addressed all matters raised by the Examiner's December 30, 2003, Office Action, Applicants respectfully request that the claims be allowed.

Respectfully submitted,

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